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OFFICE OF PETITIONS

In re Application	:
Schalm, et al.	:
Application No. 09/689,637	: DECISION ON APPLICATION
Filed: October 13, 2000	: FOR PATENT TERM ADJUSTMENT
Atty Docket No. 07873.0002	:

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)," filed June 22, 2004. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to six hundred forty (640) days.

The application for patent term adjustment is **GRANTED**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **six hundred forty (640) days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On March 22, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above identified application. The Notice stated that the patent term adjustment (PTA) to date is zero (0) days. On June 22, 2004, Applicants timely¹ submitted the instant application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is six hundred forty (640) days.

Applicants assert entitlement to a patent term adjustment of six hundred forty (640) days on the basis that the PTO improperly assessed Applicants a delay of ninety-six (96) days for responding to a Notice to File Missing Parts mailed on November 28, 2000. Applicants assert that they filed a response on April 30, 2001, and as such should only have been assessed delay of sixty-one (61) days. In addition, Applicants assert that the PTO improperly assessed Applicants a delay of six hundred sixty-eight (668) days for filing a supplemental response pursuant to 37 C.F.R. § 1.704(c)(8). Applicants assert that the amendment filed on October 20, 2003, was a duplicate of a amendment previously filed on December 21, 2001, and as such, no Applicant delay should be assessed.

Applicants state that the patent issuing from the application is not subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of zero (0) days based on an adjustment for PTO delay of seven hundred one (701) days pursuant to 35 U.S.C. 154(b)(1)(A)(ii) and 37 C.F.R. § 1.703(a)(2), reduced by Applicants' delays of ninety-eight (98) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b) and six hundred sixty-eight (668) days pursuant to 35 U.S.C. 154(b)(2)(C)(i) and 37 C.F.R. § 1.704(c)(8). The adjustments of 96 and 668 days are at issue.

The adjustment of ninety-six (96) days has been found to be incorrect. A review of the application file reveals that a Notice to File Missing Parts of Nonprovisional Application was mailed on November 28, 2000. Applicants filed a complete response to this notice on April 30, 2001. As this was not timely pursuant to 37 CFR 1.704(b), applicant delay of sixty-one (61) days should have been assessed, not ninety-six (96) days.

¹ Applicants filed the application for patent term adjustment together with the payment of the issue fee.

The adjustment of six hundred sixty-eight (668) days has been found to be correct. Applicants filed an amendment on December 21, 2001. Applicants filed a duplicate copy of the amendment on October 20, 2003, together with a letter stating that they were filing the duplicate in response to the Examiner's request. Accordingly, no applicant delay should have been assessed under 37 C.F.R. § 1.704(c)(8).

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **six hundred forty (640) days** (701 days of PTO delay and 61 days of applicant delay).

The Office acknowledges submission of the \$200.00 fee set forth in 37 C.F.R. § 1.18(e).

The application file is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

Karin A. Ferriter
for

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Revised PAIR Screen